

PATENT
App. Ser. No.: 10/838,061
Atty. Dkt. No. ROC920030156US1
PS Ref. No.: IBMK30156

REMARKS

This is intended as a full and complete response to the Office Action dated January 17, 2006, having a shortened statutory period for response set to expire on April 17, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-22 are pending in the application. Claims 10-16, 18, 20, and 22 remain pending following entry of this response. Claims 10-13, 15, 16, 18, 20, and 22 have been amended. Claims 1-9, 17, 19, and 21 have been cancelled. New claims 23-33 have been added to recite aspects of the invention. Applicant submits that the amendments and new claims do not introduce new matter.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3, 8, and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated by *Broyles et al.* (U.S. Patent No. 5,978,913, hereinafter "*Broyles*").

Claims 1-3, and 8 have been cancelled, thus obviating this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant submits that in light of the current amendments, *Broyles* does not disclose "each and every element as set forth in the claim". For example, regarding claims 10 and 15 *Broyles* does not disclose providing a graphical user interface screen to allow a user to specify periods of time associated with each of a plurality of diagnostic tests. *Broyles* only discloses a visual interface to notify a user about the launch of a full boot process (*Broyles*, Column 5, Lines 60-64), and that the invention in *Broyles* may be practiced in a windows operating system.

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Therefore, the claims 10, 15, and the dependents therefrom are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of obviousness.

Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Broyles*

Claims 4-7, and 9 have been cancelled, thus obviating the rejection.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Broyles* in view of *Ikeda et al.* (U.S. Patent No. 5,349,664, hereinafter *Ikeda*).

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Broyles* in view of *Ikeda* as applied to claim 18 above, and further in view of *Rockwell et al.* (U.S. Patent No. 5,479,599, hereinafter *Rockwell*).

Claim 18 has been amended to include the limitations of claims 19 and 21.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first criteria.

For example, regarding claim 18, there is no suggestion or motivation either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the references to disclose a graphical user-interface screen allowing a user to specify periods of time associated with each of a plurality of diagnostic tests. Examiner suggests that *Rockwell* discloses a graphical user interface (GUI) screen. However, the GUI screens disclosed in *Rockwell* only

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disclose a display to group one or more processors in a multi-processor environment, activate/deactivate the groups, and display status of the groups. See *Rockwell*, Column 2, Lines 26-55. *Rockwell*, does not disclose any GUI screens for receiving user selections related to performing diagnostic testing. Therefore, there is no suggestion or motivation to combine or modify *Rockwell* with other references to disclose a GUI screen to specify periods of time associated with each of one or more diagnostic tests.

Therefore, the claim 18 and the dependents therefrom are believed to be allowable, and allowance of the claims is respectfully requested.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Broyles*, *Ikeda*, and *Rockwell*, as applied to claim 19 above, and further in view of *Wang et al.*, "The New Testability Sins: Don't Atone, Avoid!" (hereinafter *Wang*).

Applicant submits that in light of the above arguments, claim 18, from which claim 22 depends is allowable. Therefore, the claim 22 is also believed to be allowable, and allowance is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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